

Appl. No. 09/918,029
Amdt. dated January 19, 2004
Response to Examiner Amendment of December 10, 2003

REMARKS

The Notice of Allowance and Examiner's Amendment mailed December 10, 2003, has been received and reviewed.

Applicants believe that no additional claim fees should be due upon entry of claims 10 to 15. However, should the Office determine that additional fees are due, the Commissioner is hereby authorized to charge the fee to deposit account 20-1469.

Telephonic Interview:

The applicants thank the Examiner for the courtesy of the telephonic interview conducted January 7, 2004, in which claim terminology was discussed.

The applicants note that the Examiner's Amendment applied the phrase "recombinant nucleic acid molecule" to the elements following the word "wherein" in claim 1 and conformed the dependent claims to this nomenclature. However, as discussed during the telephonic interview, the elements following the word "wherein" properly define the precursor molecule which is acted upon by the nucleic acid polymerase to produce the claimed recombinant nucleic acid molecule. For example, the recombinant nucleic acid is not in an essentially single stranded form, rather the precursor molecule is essentially single stranded with the hairpin structure at the 3' terminus forming a start-site for the nucleic acid polymerase. Thus, the applicants have amended the elements to reference the precursor molecule and clarified the relationship between the precursor molecule and the recombinant nucleic acid.

As agreed in the telephonic interview, the term "essentially" has been reinserted before the term "single stranded" because a single stranded nucleic acid that may form a hairpin is technically not completely single-stranded when the hairpin is actually present. Therefore, the term "essentially" is present to clarify this feature.

Formal Changes in the Claims, Without Changing the Scope Thereof:

The amendments to claims 1-9 represent formal matters in the claims without changing the scope thereof. Specifically, the phrases "precursor molecule" and "recombinant nucleic acid"

Appl. No. 09/918,029
Amdt. dated January 19, 2004
Response to Examiner Amendment of December 10, 2003

are applied to the appropriate nucleic acids of the claim. Thus, the amendment is necessary to properly define the nucleic acids in the claims. Because the amendment simply conforms the names of the relevant nucleic acids no new search is required, as the claim scope remains unchanged. Claims 1-9 are patentable for the same reasons that claims 1-9 as presented in the Examiner's Amendment are patentable.

Amendments Adding Claims:

As suggested by the Examiner during the interview of January 7, 2004, new claims 10 to 15 have been proposed in method claim format. Claims 10 to 15 merely present the elements of claims 1, 3-5, 8 and 9 as method claims. For example, new claim 10 introduces the phrase "providing" as the action relating to the complementing cell, "introducing" as the action relating to the precursor molecule in the complementing cell and "producing" as the action by which the nucleic acid polymerase in the complementing cell produces the claimed recombinant nucleic acid.

Thus, claims 10-15 should be patentable for at least the same reasons claims 1-9 are patentable. Further, no new search is necessary, as the elements of the method claims correspond to the elements of the composition claims.

Appl. No. 09/918,029
Amdt. dated January 19, 2004
Response to Examiner Amendment of December 10, 2003

CONCLUSION

This amendment is submitted prior to the payment of the issue fee and, therefore, no petition or fee is required. No new matter has been added. In the event questions remain after consideration of these remarks and amendments, the Office is kindly requested to contact applicant's attorney at the number given below.

Respectfully submitted,



G. Scott Dorland, Ph.D.
Registration No. 51,622
Attorney for Applicants
TRASKBRITT, P.C.
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: January 19, 2004
GSD/gsd